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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/054,451	01/18/2002	Petro Estakhri	38979-0080US	5311

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10/06/2003

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EXAMINER

NAMAZI, MEHDI

ART UNIT

PAPER NUMBER

2188

DATE MAILED: 10/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/054,451

Applicant(s)

ESTAKHRI, PETRO

Examiner

Mehdi Namazi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4 and 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-19 are presented for examination.

Information Disclosure Statement

2. The information disclosure statement filed October 18, 2002 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-19 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1-6 of copending Application No. 10/136,583. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter claimed in the instant

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application is fully disclosed in the co-pending application, and both applications are claiming common subject matter, as follows: a one – time programmable nonvolatile memory organized into sectors, a controller for rewriting data into some of the sectors. Both applications claim relocating data in order to have a faster access by clients to the data. A comparison of independent claims 1, 12, and 17-19 of instant application with claims 1, and 3-4 of application 10/136,583 reveals that the instant application claim defines a generic embodiment of the species covered by the application claims 1, 12, and 17-19 are anticipated by co-pending application species claims 1, and 3-4 of application 10/136,583 and therefore precludes the issuance of application claims 1, and 4 accordance with In re Goodman. Stated differently, co-pending application claims 1, and 3-4 already cover, or “read on”, claims 1, 12, and 17-19 of the instant application. This is essentially epitome of obviousness since the instant application claims are not “in any way unobvious” over the co-pending application claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Conley (U.S. Patent No. 6,426,893).

As per claims 1, 12, 17-19, Conley teaches a digital equipment system comprising:

- a. a host for sending commands to read or write files having sectors of information (col. 4, lines 7-11), each sector having and being modifiable on a bit-by-bit, byte-by-byte or word-by-word basis, said host being operative to receive responses to said commands (it is inherent for all blocks or sectors to be modified based on bit-by-bit) ;
- b. a controller device responsive to said commands (fig. 1A, element 11), and including, one-time-programmable nonvolatile memory for storing information organized into sectors, based on commands received from the host and upon receiving commands from the host to re-write a sector, the controller device for re-writing said sector on a bit-by-bit, byte by-byte or word-for-word basis (col. 6, lines 12-30).

As per claims 2, and 13, Conley teaches one-time-programmable nonvolatile memory includes a system area and a data area, said system area for storing

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information pertaining to the organization of the information stored or to be stored in the data area (col. 6, lines 22-30).

As per claim 3, Conley teaches the sytem area includes storage areas for including Original Engineering Manufacturer (OEM) identification/Bidirectional Input/Output System (BIOS), a File Allocation Table (FAT) 1, a FAT 2 and root disk directory information (inherent).

As per claims 4, and 14, Conley teaches the controller device further includes a first buffer for storing a host-provided sector and a second buffer for storing sectors stored or to be stored in the one-time-programmable nonvolatile memory (fig. 1A, element 35).

As per claims 5, and 15, Conley teaches a comparator coupled between said first and second buffer for comparing a sector to be modified or accessed by the host with those sectors to which information has been previously written (fig. 6 A, element 125).

As per claims 6, and 16, Conley teaches wherein during power-up, said controller device for identifying the end-of-file, wherein the location following the location in which the end-of-file resides is identified as the location for the start-of-file of a new file to be stored (col. 10, lines 5-21).

As per claim 7, Conley teaches the end-of-file is identified by the use of a flag (inherent).

As per claim 8, Conley teaches wherein said files are digital photographs(it could be any type of data).

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As per claim 9, Conley teaches wherein said files are archives (inherent).

As per claim 10, Conley teaches wherein said controller device maintains a correlation between logical addresses and physical addresses for translating host-provided addresses to addresses recognized by the one-time-programmable nonvolatile memory (inherent).

As per claim 11, Conley teaches wherein said controller for maintaining track of defective locations within the one-time-programmable nonvolatile memory (col. 6, lines 12-18).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mehdi Namazi whose telephone number is 703-306-2758. The examiner can normally be reached on Monday-Friday 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mano Padmanabhan can be reached on 703-306-2903. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-9600.

Mehdi Namazi
Examiner
Art Unit 2188
September 30, 2003

Mano Padmanabhan
9/30/03
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SUPERVISORY PATENT EXAMINER
TC 2100